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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,181	08/05/2003	Jie Jack Li	PC25250A	7105
28880	7590	01/28/2004		EXAMINER
WARNER-LAMBERT COMPANY				AULAKH, CHARANJIT
2800 PLYMOUTH RD				
ANN ARBOR, MI 48105			ART UNIT	PAPER NUMBER
				1625

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/634,181	LI, JIE JACK
	Examiner Charanjit S. Aulakh	Art Unit 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>01/21/04</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1-14 are pending in the application.

### *Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to compounds of formula I where Y1 represents  $-C(O)$ , Y2 and Y3 together form  $-C(R3)=N$  and Q represents  $OC(O)$ ,  $CH(R5)C(O)$ ,  $CH(R5)C(NR5)$ ,  $CH_2N(R5)$ ,  $CH(R5)C(S)$ ,  $(H)C=C(H)$ ,  $C\equiv C$ ,  $CH_2C\equiv C$ ,  $C\equiv CCH_2$ ,  $CF_2C\equiv C$ ,  $C\equiv CCF_2$  or  $C\equiv CC(O)$ , pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 544, subclass 279.
- II. Claims 1-5 and 10-14, drawn to compounds of formula I where Y1, Y2, Y3 and Q are other than defined above for group I, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 546, subclass 112.

3. The inventions I and II as defined above are patentably distinct, each from the other since they are structurally so divergent that a reference showing compounds of invention I would not render compounds of invention II *prima facia* obvious. Search required for e.g ; compounds of invention I in class 544 is not the same search required for e.g ; compounds of invention II in class 546 and therefore, constitutes a burdensome search.

4. During a telephone conversation with the applicant's attorney, Mr. Claude F. Purchase on Jan. 21, 2004, a provisional election was made with traverse to prosecute

the invention of group I ( Compounds of formula II of claim 6 as species ), claims 1-14.

Affirmation of this election must be made by applicant in replying to this Office action. It is of note that group II is subject to further restriction based on the values of variables Y1, Y2, Y3 and Q in the future applications.

#### ***Claim Objections***

5. Claims 5, 11 and 14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternate only. See MPEP § 608.01(n).

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-5, 7 and 9-14 depend directly or indirectly upon claims 1, 6 or 8. In claims 1, 6 and 8, the term ---pyrido-N-oxide--- is indefinite since it is not clear whether the oxide is attached to the N where variable Q is attached or is attached to the N where variable R2 is attached.

In claims 6 and 8, the variables R1 and R2 are not defined. The applicants are suggested to either make them dependent upon claim 1 or define these variables.

8. Claims 1-5 and 10-14 are objected as being containing non-elected subject matter.

***Allowable Subject Matter***

9. The following is a statement of reasons for the indication of allowable subject matter:

The instant compounds directed to the elected subject matter are allowable over the prior art since they are neither disclosed nor obvious over the prior art. In the prior art, Lubisch ( U.S. Patent no. 6,414,157 ) discloses 3-substituted tetrahydropyridopyrimidinone derivatives which are closely related to the instant compounds. However, the closely related compounds ( see compounds 61-108 and 199-219 in the table in columns 11-18 ) disclosed by Lubisch differ from the instant compounds in having a different Q variable attached to the N and furthermore, there is no teaching, suggestion or motivation in the prior art to modify the compounds of Lubisch to prepare the instant compounds.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (703)305-4482. The examiner can normally be reached on Monday through Thursday, 7:30 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.

*C. S. Aulakh*  
Charanjit S. Aulakh

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Primary Examiner  
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